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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/078,366 | 02/21/2002 | John Keane | 7937.0003 | 4963 |
| 22852 | 7590 | 05/16/2006 | EXAMINER | |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413 | | | MANIWANG, JOSEPH R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2144 | |

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,366

Applicant(s)

KEANE ET AL.

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 and 45-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 and 45-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>04/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/13/06 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on 04/13/06 was in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement was considered by the Examiner.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the "network operation center" as described in the Specification on p. 10, paragraph [038]. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

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include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-43 and 45-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. Independent claims 1, 15, 26, and 31 in general recite detecting an addressing conflict between a first address of a first processor and a second address of a second processor prior to receiving packets from the processors. Examiner submits that such a concept is not enabled by the Specification.

7. The first of only two instances in the Detailed Description of any conflict detection mechanism describes a "network operation center" that detects the address conflict (see paragraph [038]). However, no detail as to how such a network operation center detects the conflict prior to receiving packets is given. Additionally, such a network operation center is not described in detail nor shown in the Figures in relation to the described embodiment. Thus, it cannot be ascertained from the supplied information how an address conflict is to be detected by the network operation center before receiving packets as claimed. It is also noted that as the network operation center is explicitly not shown in the Figures, the network operation center cannot be any of the elements shown in the Figures, specifically including the gateways 1500-1520.

8. The second instance in the Detailed Description of a conflict detection mechanism describes detecting an address conflict only after exchanging information between a first and second processor (see paragraph [050]). Examiner submits that this is contradictory to the claimed invention, which requires that the conflict be detected prior to communication between the first and second processors. Additionally, this portion of the Specification does not describe detecting the addressing conflict on a processor other than the first or second processors as claimed, but instead describes detecting such a conflict on the first processor. It is further submitted that this section of

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the Specification does not further detail the conflict detection mechanism in paragraph [038], since this section details detecting a conflict at a gateway, which as noted above cannot be a "network operation center". Thus, it is submitted that the Specification does not enable the claim limitation of detecting an addressing conflict between a first and second processor prior to receiving packets from the processors as claimed.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-43 and 45-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Tuomenoksa (U.S. Pat. No. 7,028,334).

11. The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

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12. Regarding claims 1, 15, 26, and 31, Tuomenoksa disclosed a method and system comprising detecting an addressing conflict between a first address of a first processor and a second address of a second processor prior to receiving packets from the processors (see column 22, line 21; column 48, lines 40-51); associating an identifier with the detected addressing conflict (see column 48, lines 23-46); receiving from the first processor one or more packets forming a tunnel (see column 47, lines 30-33); removing from the one or more packets information about the tunnel, the removed tunnel information including a virtual address of the tunnel (see column 47, lines 45-60); determining that the one or more packets are associated with the detected addressing conflict by determining that the removed virtual address corresponds to the identifier associated with the detected addressing conflict (see column 49, lines 20-36); determining a translated address based on the removed virtual address (see column 49, lines 20-36); and forwarding the one or more packets based on the translated address (see column 49, lines 20-36).
13. Regarding claims 2, 16, and 27, Tuomenoksa disclosed the method and system further comprising detecting that the first address is the same as the second address (see column 48, lines 29-33).
14. Regarding claims 3, 17, 28, and 32, Tuomenoksa disclosed the method and system further comprising detecting that the first address is the same as the second address based on information about the first processor and the tunnel (see column 48, lines 29-33).

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15. Regarding claims 4, 18, and 29, Tuomenoksa disclosed the method and system further comprising removing information indicating the virtual address, the virtual address uniquely identifying the tunnel (see column 20, lines 26-49).

16. Regarding claims 5, 19, and 30, Tuomenoksa disclosed the method and system further comprising removing information indicating a virtual IP address of the tunnel (see column 20, lines 26-49).

17. Regarding claims 6 and 20, Tuomenoksa disclosed the method and system further comprising determining, based on the removed virtual address and the identifier, that the first address in the one of more packets causes the addressing conflict (see column 48, lines 23-60).

18. Regarding claims 7 and 21, Tuomenoksa disclosed the method and system further comprising determining the translated address based on the first address (see column 49, lines 20-36).

19. Regarding claims 8 and 22, Tuomenoksa disclosed the method and system further comprising mapping the first address into the translated address, such that the one or more packets are forwarded on a network other than the first and second networks without the addressing conflict (see column 49, lines 20-36).

20. Regarding claims 9 and 23, Tuomenoksa disclosed the method and system further comprising mapping the first address into the translated address, such that the one or more packets are forwarded on the second network without the addressing conflict (see column 49, lines 20-36).

21. Regarding claims 10 and 24, Tuomenoksa disclosed the method and system further comprising mapping the first address into the translated address, such that the one or more packets are forwarded on the first network without the addressing conflict (see column 49, lines 20-36).

22. Regarding claims 11, 25, and 33, Tuomenoksa disclosed the method and system further comprising mapping, at a gateway, the first address into the translated address (see column 49, lines 20-36).

23. Regarding claim 12, Tuomenoksa disclosed the method and system further comprising detecting the addressing conflict at a gateway interfacing a network other than the first and second networks (see column 22, lines 12-30).

24. Regarding claim 13, Tuomenoksa disclosed the method and system further comprising detecting the addressing conflict at a gateway interfacing the second network (see column 22, lines 12-30).

25. Regarding claim 14, Tuomenoksa disclosed the method and system further comprising detecting the addressing conflict at a gateway interfacing the first network (see column 22, lines 12-30).

26. Regarding claim 34, Tuomenoksa disclosed the method and system wherein the other processor resolves the conflict based on another virtual address of another tunnel established between the other processor and the second network (see column 16, lines 4-24).

27. Regarding claim 35, Tuomenoksa disclosed the method and system wherein the other processor resolves the conflict such that communication between the second

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processor and the first network is enabled (see column 16, lines 4-24; column 49, lines 20-36).

28. Regarding claims 36 and 45, Tuomenoksa disclosed the method and system further comprising forming the tunnel, such that a first protocol encapsulates a second protocol (see column 14, lines 41-62).

29. Regarding claims 37 and 46, Tuomenoksa disclosed the method and system further comprising using the first protocol as an Internet Protocol (IP) (see column 14, lines 41-62).

30. Regarding claims 38 and 47, Tuomenoksa disclosed the method and system further comprising user the second protocol as an Internet Protocol (IP) (see column 14, lines 41-62).

31. Regarding claims 39 and 48, Tuomenoksa disclosed the method and system further comprising defining the second protocol to further include an encryption protocol (see column 14, lines 41-62).

32. Regarding claims 40 and 49, Tuomenoksa disclosed the method and system further comprising removing from the one or more packets the virtual address of the tunnel, the virtual address uniquely identifying the tunnel and being routable on a virtual network (see column 20, lines 26-49).

33. Regarding claims 41 and 50, Tuomenoksa disclosed the method and system further comprising determining the translated address, such that the addressing conflict is resolved with respect to the first network without regard to a possible addressing conflict on a network other than the first network (see column 49, lines 20-36).

34. Regarding claims 42 and 51, Tuomenoksa disclosed the method and system further comprising determining the translated address, such that the addressing conflict is resolved between the first and second networks without regard to a possible addressing conflict on a network other than the first and second networks (see column 49, lines 20-36).

35. Regarding claims 43 and 52, Tuomenoksa disclosed the method and system further comprising determining the translated address, such that the addressing conflict is resolved without consent of another processor (see column 49, lines 20-36).

36. Regarding claim 53, Tuomenoksa disclosed the method and system further comprising determining the translated address, such that the addressing conflict is resolved by the first and second processors without regard to another processor (see column 49, lines 20-36).

37. Regarding claim 54, Tuomenoksa disclosed the method and system wherein the other processor determines the translated address without regard to the first and second networks, such that the addressing conflict is resolved locally on a network other than the first and second networks (see column 49, lines 20-36).

38. Regarding claim 55, Tuomenoksa disclosed the method and system wherein the other processor determines the translated address, such that the addressing conflict is resolved on a network other than the first and second networks (see column 49, lines 20-36).

39. Regarding claim 56, Tuomenoksa disclosed the method and system further comprising storing the translated address with the identifier associated with the detected

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addressing conflict (see column 48, line 23 through column 49, line 36); and wherein determining a translated address based on the removed virtual address comprises retrieving, based on the identifier, information indicating the translated address (see column 48, line 23 through column 49, line 36).

Response to Arguments

40. Applicant's arguments with respect to claims 1-45 and 45-56 have been considered but are moot in view of the new ground(s) of rejection. Examiner submits that the claims are taught by the prior art of record as detailed in the above rejection under 35 U.S.C. 102(e).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tuomenoksa (U.S. Pat. App. Pub. 2002/0099937)

Keane et al. (U.S. Pat. No. 6,996,628)

Bandinelli et al. (U.S. Pat. No. 6,631,416)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

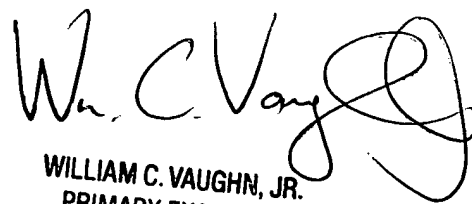
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER